



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

m2

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------------|
| 09/805,978 | 03/15/2001 | Yoshinori Ohta | 5-027US-FF | 3790 |
| 21254 7590 10/09/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | EXAMINER HEWITT II, CALVIN L | |
| | | | ART UNIT 3621 | PAPER NUMBER |
| | | | MAIL DATE 10/09/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/805,978

Applicant(s)

OHTA, YOSHINORI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17 and 19-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-14, 16, 17 and 19-33 have been examined.

Response to Amendment/Argument

2. Webster's New World College Dictionary Fourth Edition defines "affiliate" as "to take in as a member or branch" or "to connect or associate (oneself) with an organization, movement, etc."

The following assertion of fact by the Examiner has gone unchallenged by the Applicant and is considered admitted prior art:

- relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID)

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 11-14, 16, 17 and 19-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by King, U.S. Patent No. 6,529,286.

As per claims King teaches an image ordering system comprising:

- a center server (figure 3, item 309; column 5, lines 8-13)
- a first client computer for an orderer (figure 1 and figure 3-items 301-303; column 3, lines 45-65; column/line 4/62-5/6)
- a plurality of second client computers (figure 3-items 304-308 and figure 4, items 305-307; column 5, lines 25-32)
- a first client computer comprising an input unit and transmitting unit (figure 1; column 3, lines 46-65; column 4, lines 47-52; column 5, lines 12-30)
- a server comprising a memory for storing correspondence data in advance wherein the data represents which of the plurality of second client computers is affiliated with the first client computer of the orderer (column 4, lines 47-52; column 5, lines 12-30), a first receiving unit for receiving image specifying data (column 5, lines 7-12, 20-22 and 35-38) and orderer specifying data (column 4, lines 47-52; column 5, lines 12-30) from the client computer, and determining on the basis of the correspondence data

which of the plurality of second client computers is affiliated with the orderer received by the receiving unit (column/line 5/18-6/31)

- a transmitting controller transmitting the image specifying data and orderer specifying data received by the receiving unit to one of the plurality of second client computers (column 6, lines 30-35)
- a second client computer comprising a second receiving unit for receiving the image specifying data and orderer specifying data (column 6, lines 30-35) and first alerting unit for giving notice of information regarding the image specifying data and orderer specifying data (column 6, lines 35-38; column 8, lines 23-30)
- storing the received image specifying data and orderer specifying data in an image database (column 5, lines 7-12, 20-22 and 35-38)
- client computer setting units for setting a second client computer and an orderer computer and transmitting the set data to the server (column 4, lines 47-52; column 5, lines 7-30)

Regarding the transmission of data specifying an orderer, King teaches a server storing a user's preferred printer list (column 2, lines 17-23; column 4, lines 47-52; column 5, lines 7-30) hence it is inherent that the orderer transmit some sort of identifier to the server in order to allow it to distinguish one orderer list from another (column 2, lines 17-23; column 4, lines 47-52; column 5, lines 7-30).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, U.S. Patent No. 6,529,286.

As per claims 25-32, King teaches Applicant's claimed system as described in claim 1. For example, King teaches storing correspondence data in server memory (column 4, lines 47-52; column 5, lines 12-30). However, King does not disclose storing correspondence data such as a table (claim 25- "a management information *database including* at least one of a *table...*" (emphasis added)) or a relationship (claim 31). Correspondence data stored in computer memory is non-functional descriptive material, and, it has been held that data stored in memory will not distinguish a claimed apparatus from the prior art when the data is not functionally related to the memory in which it is stored (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II) or when the prior art teaches the claimed structural limitations (*In re Rishoi*, 94

USPQ 71 (CCPA 1952)). Therefore, the server database (claims 23 and 25-32) (column 4, lines 47-52; column 5, lines 12-30), that associates a user with her/his printer preferences and a second client computer memory (claim 24) (column 6, lines 35-38; column 8, lines 23-30) are sufficient to render Applicant's claimed server memory as obvious to one of ordinary skill.

Alternatively, the Examiner takes Official Notice that relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID) are old and well known (claims 25-32). Hence, it would have been obvious to one of ordinary skill to use a relational database in order to more efficiently retrieve or find which of a plurality of second client computers is affiliated with a first client computer.

7. Claim 1-7, 11-14, 16, 17, and 19-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of King, U.S. Patent No. 6,529,286.

As per claims 1-7, 11-14, 16, 17, and 19-33 (correcting a typo, in the Office Action it was incorrectly written as 19-24), Freedman teaches an image ordering system comprising:

- a server (figure 1A- item10), first client computer (figure 1A- item 12) and a second computer (figure 1A- item 36) connected via a communication network (figures 1A-B)

- a first client computer comprising: an input unit for specifying an image and a transmitting unit for transmitting to a server said image specifying data (abstract; figures 1A-B)
- server comprising: receiving unit for receiving image specifying data, transmitting unit for image and orderer specifying data to a second client computer (abstract; figures 1A-B; column/line 7/62-8/35)
- a server with an image database for storing thumbnail images (column/line 8/55-9/63)
- a server with calculation unit that calculates an estimated fee for printing an image based on image specifying data, transmitting the fee (e.g. of orderers affiliated with a second client computer) to a client computer (column/line 9/63-10/35)
- a first client computer that receives a fee estimate from the server and an alerting unit for giving notice of the estimate (column/line 9/63-10/35)
- second client computer comprising: receiving unit for receiving image specifying and orderer data, printer controller, and an alerting unit (abstract; figures 2B; column 8, lines 1-20; column 10, lines 27-35)
- a first setting unit for setting at least one of a lab affiliated with an agency and an orderer affiliated with a lab and for transmitting this data to a server (column/line 7/62-8/14; column 10, lines 15-35)

Freedman also teaches an image ordering system that comprises a server transmitting order parameters to a first and second client computers (column 10, lines 15-35). Freedman teaches a second client computer giving notice of information received regarding received data such as acceptance of a print job and responses to inquiries regarding job status (column 10, lines 31-54). Freedman doesn't specifically recite transmitting fee data or orderer specifying data to a second client computer. However, Freedman recites the server transmitting image specifying data and all other parameters and other information to second client computer (column 10, lines 27-35), hence, it would have been obvious to one of ordinary skill for the server to send first client identity data and/or a replica of the receipt (e.g. specifying data, prices) sent to the first client computer (column 10, lines 33-35) to facilitate the matching and resolution, in the case of discrepancies, of orders. However, Freedman does not specifically storing order data for use in subsequent orders. King teaches a server comprising a memory for storing correspondence data in advance wherein the data represents which of the plurality of second client computers is affiliated with the first client computer of the orderer (column 4, lines 47-52; column 5, lines 12-30) and using the correspondence data to determining on the basis of the correspondence data which of the plurality of second client computers is affiliated with the orderer received by the receiving unit (column/line 5/18-6/31).

Therefore it would have been obvious to one of ordinary skill to combine the teachings of Freedman and King to allow a user to pick-up a print order from a preferred printing facility ('286, column 4, lines 48-51).

As per claims 25-32, King teaches Applicant's claimed system as described in claim 1. For example, King teaches storing correspondence data in server memory (column 4, lines 47-52; column 5, lines 12-30). However, King does not disclose storing correspondence data such as a table (claim 25- "a management information *database including* at least one of a *table...*" (emphasis added)) or a relationship (claim 31). Correspondence data stored in computer memory is non-functional descriptive material, and, it has been held that data stored in memory will not distinguish a claimed apparatus from the prior art when the data is not functionally related to the memory in which it is stored (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II) or when the prior art teaches the claimed structural limitations (*In re Rishoi*, 94 USPQ 71 (CCPA 1952)). Therefore, the server database (claims 23 and 25-32) (column 4, lines 47-52; column 5, lines 12-30), that associates a user with her/his printer preferences and a second client computer memory (claim 24) (column 6, lines 35-38; column 8, lines 23-30) are sufficient to render Applicant's claimed server memory as obvious to one of ordinary skill.

Alternatively, the Examiner takes Official Notice that relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID) are old and well known (claims 25-32). Hence, it would have been obvious to one of ordinary skill to use a relational database in order to more efficiently retrieve or find which of a plurality of second client computers is affiliated with a first client computer.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 and King, U.S. Patent No. 6,529,286, as applied to claim 5 above, and in further view of Greulich et al., U.S. Patent No. 6,018,338.

As per claims 8-10, Freedman teaches a network ordering method and system that connects over a communication link a server, a first client computer and a second client computer and transmits image specifying data and all other parameters and other information between the parties (abstract; figures 1A-2B; column 10, lines 27-35). Freedman also teaches a first client computer providing a server with payment data (column 8, lines 1-10) and a second client computer accepting the order (column 10, lines 30-35). The latter, suggests, to one of ordinary skill, a verification unit and that a second client computer may choose not to accept the order if the order data and all other parameters and other information was found unacceptable. King teaches a server comprising a

memory for storing correspondence data in advance wherein the data represents which of the plurality of second client computers is affiliated with the first client computer of the orderer (column 4, lines 47-52; column 5, lines 12-30) and using the correspondence data to determining on the basis of the correspondence data which of the plurality of second client computers is affiliated with the orderer received by the receiving unit (column/line 5/18-6/31). However, neither Freedman nor King specifically recite transmitting fee data to a third client computer. Greulich et al. teach a network ordering system and method that comprises a third party for verifying a first client ability to pay for a service provided by the second client computer (figure 1; column 5, lines 45-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman, King and Greulich et al. in order to prevent fraud.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Zingher discloses a print allocation system
- Yamada teaches a user saving at a central server location preferences for picking up an order

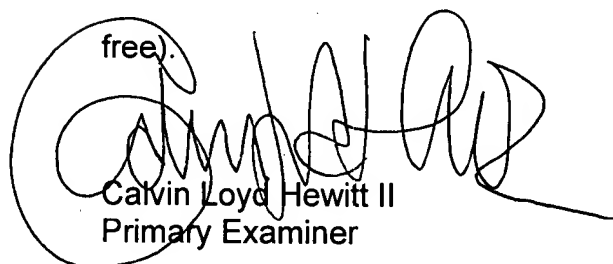
Art Unit: 3621

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

September 13, 2007



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR